



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/726,708	12/04/2003	Yasuo Mori	00862.023354.	7041
5514	7590	07/13/2006	EXAMINER	
FITZPATRICK CELLA HARPER & SCINTO			BOTTS, MICHAEL K	
30 ROCKEFELLER PLAZA			ART UNIT	
NEW YORK, NY 10112			PAPER NUMBER	

2176

DATE MAILED: 07/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/726,708

Applicant(s)

MORI ET AL.

Examiner

Michael K. Botts

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This document is a Final Office Action on the merits. This action is responsive to the following communications: Response to Office Action, which was filed on April 14, 2006.
2. Claims 1-25 are currently pending in the case, with claims 1, 7, 13, 17, 18, 19, 20, and 23 being the independent claims.
3. Claims 1-25 are rejected.

Claims Rejection – 35 U.S.C. 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. **Claims 1-19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Usami, et al (U.S. Patent 5,363,480, issued November 8, 1994) [hereinafter "Usami"] in view of Orr, et al. (U.S. Patent 5,895,477, issued April 20, 1999) [hereinafter "Orr"].

Regarding **independent claim 1, as amended**, Usami in view of Orr teaches:

A document processing apparatus for a structured document formed by at least one group having a specific attribute, wherein each of the at least one

group contains at least one page, each of which has a print attribute, said apparatus comprising:

a display controller which controls display of an object as an image indicating at least one original page contained in the document;

an instruction unit which accepts an instruction from a user to insert a new page into the document, on a screen on which the object is displayed as the image by said display controller; and

an editor which edits the document so as to generate a new group containing the new page and to insert the new group into the document in accordance with the instruction accepted by said instruction unit,

wherein said display controller controls display of the objects including an object corresponding to the new group, using the document edited by said editor.

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with an original page contained in the object and does not teach inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages.

Art Unit: 2176

because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

Regarding **dependent claim 2, as amended**, Usami in view of Orr teaches:

The apparatus according to claim 1, wherein said display controller displays a selection window capable of selecting whether to edit the document so as to insert the new group containing the designated original page to a designated position or whether to move a designated original page to the designated position in accordance with designation of the original page and the position of the objects, and said editor performs editing processing in accordance with selection in the selection window.

(See rejection of Claim 1, above, and see also, Orr, Figures 1-2, teaching an editing window with "File," "Edit," "View," and "Insert" functions.)

Regarding **dependent claim 3, as amended**, Usami in view of Orr teaches:

The apparatus according to claim 1, wherein the group has a group attribute, and said editor causes the new inserted group to inherit an attribute of the group.

Art Unit: 2176

(See rejection of Claim 1, above, and see also, Orr, col. 3, lines 27-34, teaching matching the edited content to the original content.)

Regarding **dependent claim 4**, Usami in view of Orr teaches:

The apparatus according to claim 1, wherein the group has a group attribute, and said editor gives a predetermined attribute to the new inserted group.

(See rejection of Claim 1, above, and see also, Orr, col. 3, lines 27-34, teaching matching the content to new components in the design tree.)

Regarding **dependent claim 5, as amended**, Usami in view of Orr teaches:

The apparatus according to claim 1, wherein the group has a group attribute, said editor causes said display controller to display a selection window capable of selecting whether to cause the new inserted group to inherit an attribute of the group, or whether to give a predetermined attribute, and said editor performs editing processing in accordance with selection in the selection window.

(See rejection of Claim 1, above, and see also, Orr, claim 7, teaching use of a content drop table to determine the content type to be used.)

Regarding **dependent claim 6**, Usami in view of Orr teaches:

The apparatus according to claim 1, wherein the group of the original pages is made to correspond to a layer of a data structure having at least one chapter which forms a document, and at least one original page is made to correspond to a lower layer of the data structure of the chapter.

(See rejection of Claim 1, above. In addition, since the invention displays a series of pages, it would be obvious to one of ordinary skill in the art at the time of the invention that the pages displayed may constitute a chapter that forms a document. Further, see, Orr, Figure 31, teaching that the original page may be modified to any form in the tree structure.)

Regarding **claims 7-12, as amended**, claims 7-12 incorporate substantially similar subject matter as claimed in claims 1-6, respectively, and are rejected along the same rationale.

Regarding **independent claim 13**, Usami in view of Orr teaches:

A document processing method of processing original data having a print format as an attribute, comprising steps of:

holding original data in a tree structure by giving an attribute to each node;
and

when separating arbitrary partial tree data in the tree structure into a plurality of partial tree data, replacing an attribute of each separated partial tree

Art Unit: 2176

with an attribute of a node of the partial tree data in accordance with an attribute before separation.

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with an original page contained in the object and does not teach inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a "design facet" that is part of the "design tree" of the composition tree structure. See, Orr, Figures 5A-7, and col. 15, line 62 through col. 16, lines 51. Further, see, Orr, col. 26, lines 26-32, teaching that the attribute of text in a dropped object may be changed or stay the same according to different user choices.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

Regarding **dependent claim 14**, Usami in view of Orr teaches:

The method according to claim 13, wherein the attribute of the separated partial tree includes an attribute value before separation.

(See rejection of claim 14 above, and, in addition, see Orr, col. 26, lines 26-31, teaching that the attributes of the added material (separated partial tree) may retain its original attributes.)

Regarding **dependent claim 15**, Usami in view of Orr teaches:

The method according to claim 13, wherein the attribute of the separated partial tree includes an attribute value designated by a user.

(See rejection of claim 14 above, and, in addition, see Orr, claim 7, teaching that the attributes of the added material (separated partial tree) may be selected by the user from a content drop table.)

Regarding **dependent claim 16**, Usami in view of Orr teaches:

The method according to claim 13, wherein the attribute of the separated partial tree can be selectively applied by a user from a plurality of attribute setting methods.

(See rejection of claim 14 above, and, in addition, see Orr, claim 7, teaching that the attributes of the added material (separated partial tree) may be selected by the user from a content drop table.)

Regarding **independent claim 17**, Usami in view of Orr teaches:

A document processing apparatus which processes original data having a print format as an attribute, comprising:

a holding unit which holds original data in a tree structure by giving an attribute to each node; and

a replacement unit which, when arbitrary partial tree data in the tree structure held by said holding unit is separated into a plurality of partial tree data, replaces an attribute of each separated partial tree with an attribute of a node of the partial tree data in accordance with an attribute before separation.

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a “design facet” that is part of the “design tree” of the composition tree structure. See, Orr, Figures 5A-7, and col. 15, line 62 through col. 16, lines 51. Further, see, Orr, col. 26, lines 26-32, teaching that the size attribute of text, which is a print attribute, in a dropped object may be changed or stay the same according to different user choices.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

Regarding **independent claim 18**, Usami in view of Orr teaches:

A program stored on a computer readable storage medium, said program for causing a computer to process a structured document formed by at least one group having a specific attribute, wherein each of the at least one group contains at least one page, each of which has a print attribute, wherein the program comprises:

code for a display control step of controlling display of an object as an image indicating at least one original page contained in the document;

a code for an instruction accepting step of accepting an instruction from a user to insert a new page into the document, on a screen on which the object is displayed as the image in said display control step; and

code for an editing step of editing the document so as to generate a new group containing the new page and to insert the new group into a document in accordance with the instruction accepted in said instruction accepting step, wherein in the display control step, display of the image objects, including an object corresponding to the new group, is controlled using the document edited in the editing step.

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a "design facet" that is part of the "design tree" of the composition tree structure. See, Orr, Figures 5A-7, and col. 15, line 62 through col. 16, lines 51. Further see, Orr, Figures 1-2, and 29, teaching control of the object in the editing step.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved

Art Unit: 2176

document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

Regarding **independent claim 19, as amended**, Usami in view of Orr teaches:

A program stored on a computer-readable medium, said program for causing a computer to process original data having a print format as an attribute, comprising:

code for a step of holding original data in a tree structure by giving an attribute to each node; and

code for a step of, when separating arbitrary partial tree data in the tree structure into a plurality of partial tree data, replacing an attribute of each separated partial tree with an attribute of a node of the partial tree data in accordance with an attribute before separation.

(Usami teaches a multiple page display for word processing including editing with a display controller that displays images of the original pages, but it does not expressly teach displaying a document structure with and original page contained in the object and does not teach an inserting a new group of pages.

Orr teaches a display controller that displays document structure and the original pages, and further, teaches the insertion of a plurality of objects to the original documents via a tree structure, and such object may include pages. In addition, Orr teaches a "design facet" that is part of the "design tree" of the composition tree structure. See, Orr, Figures 5A-7, and col. 15, line 62 through col. 16, lines 51. Further,

Art Unit: 2176

see, Orr, claim 17, teaching that modification of the content to be dropped, the partial tree data, may be edited within the tree structure.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Usami with Orr to result in a word processing program that displayed the document by pages and to make insertions by pages with and without attribute modifications because both programs deal with the creation and manipulation of electronic documents. Suggestion for a page by page insertion according to the invention of Orr is taught by Orr in Figures 1 and 2, teaching a saved document that is edited through a user interface with an associated edited version which is then processed to a multi-page information presentation.)

5. **Claims 20-25** are rejected under 35 U.S.C. 103(a) as being unpatentable over Orr, et al. (U.S. Patent 5,895,477, issued April 20, 1999) [hereinafter "Orr"].

Regarding **independent claim 20**, Orr teaches:

A document processing apparatus for processing document data containing chapters, each of which contains pages, comprising:

obtainment means for obtaining data containing pages; and

generation means for, when said obtainment means has obtained data containing pages, generating a new chapter which is different from chapters currently contained in the document data and which contains the pages obtained by said obtainment means.

Art Unit: 2176

(See, Orr, figures 19-22, and 38, and col. 23, line 63 through col. 26, line 44, teaching the insertion of a word processing document into another document.

Orr does not expressly teach that the document "contains chapters." It would have been obvious to one of ordinary skill in the art that insertion of word processing text into a document may include a situation wherein the document is a part of a book or a "chapter."

The Examiner takes official notice of the fact that it was well known by one of ordinary skill in the art at the time of the invention that word processors were used to write books with the ability to edit the text in the books, that some form of "attainment means" was used for identifying content to be edited into a word processing document, and that such editing was done with such commonly available word processing programs as Wordstar, Word Perfect, and Microsoft Word. It was further well known that books may include chapters, and that the editing of text in a book may result in the editing of text in a chapter to result in a "new chapter."

It is inherent that insertion of a new word processing document into a old document results in a new combined document. Therefore, it is also inherent that if the old document was a "chapter," as was well known to one of ordinary skill in the art at the time of the invention, the new combined document would, necessarily and inherently, be a "new chapter which is different from chapters currently contained in document data.")

Regarding **dependent claim 21**, Orr teaches:

An apparatus according to claim 20, wherein said obtainment means obtains data containing pages by import, and said generation means generates a new chapter containing the pages obtained by said obtainment means by import to insert the new chapter into the document data.

(See, Orr, col. 24, lines 4-56, teaching an obtainment means by "import" identifying means of import such as file name, URL address, computer interface, computer network, etc.

See, Orr, col. 23, line 63 through col. 26, line 44, teaching "inserting" as "dropping" to generate a new document.

As discussed in rejection of claim 21, above, the document of as a "chapter" would have been obvious to one of ordinary skill in the art at the time of the invention.)

Regarding **dependent claim 22**, Orr teaches:

An apparatus according to claim 20, wherein, in response to an instruction to divide a chapter contained in the document data, said obtainment means obtains data containing pages constituting a portion of the chapter instructed to be divided, and

said generation means generates a new chapter containing the pages obtained by said obtainment means to insert the new chapter into the document data.

Art Unit: 2176

(See, Orr, figures 19-21, and col. 24, line 57 through col. 26, line 44, teaching dividing a document and that new text is inserted into the document, which may be pages inserted into a chapter, and a new chapter is created. Orr does not expressly teach that the new document is a chapter. As discussed in rejection of claim 21, above, the document of as a "chapter" would have been obvious to one of ordinary skill in the art at the time of the invention.)

Regarding **claims 23-25**:

Claims 23-25 incorporate substantially similar subject matter as claimed in claims 20-22 and are rejected along the same rationale.

6. It is noted that any citations to specific, pages, columns, lines, or figures in the prior art references and any interpretation of the references should not be considered to be limiting in any way. A reference is relevant for all it contains and may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See, MPEP 2123.

Response to Arguments

Applicants' arguments filed April 14, 2006 have been fully considered, but they are not persuasive.

Art Unit: 2176

Regarding rejections of claims 1, 7, and 18:

Applicants argue specifically in reference to claim 1, and inferentially to claims 7 and 18 as corresponding claims to claim 1.

First: Applicants argue that the references do not disclose or suggest “editing a document by generating a new group containing a new page and inserting the new group into the document in accordance with an instruction accepted from a user.” See, Amendment, paged 12-13.

The Examiner disagrees.

See, Orr, Figures 19-23, and col. 23, line 63 through col. 26, line 44, teaching dropping content into a document. Specifically, the content “group” may include content such as a title, a first subheading with a body of text, and a second subheading with two bodies of text. See, Orr, col. 24, lines 8-19. The “group” is then dropped, or “inserted” into the group in accordance with instruction from a user. See, Orr, col. 24, lines 36-56. User actions may be performed in a variety of well known ways. See, Orr, col. 24, lines 36-45. The old content and the new content then become a new “group.” See, Orr, figure 19, element 288, teaching dropping or inserting a “page.”

Second: Applicants argue that the references do not disclose or suggest “displaying objects including an object corresponding to the new group, using the edited document.” See, Amendment, paged 12-13.

The Examiner disagrees.

See, Orr, figure 19, teaching the display of the objects corresponding to the new group, elements 284 and 286, using the edited document, element 282.

Regarding rejections of claims 13, 17, and 19:

Applicants argue specifically in reference to claim 13, and inferentially to claims 17 and 19 as corresponding claims to claim 13.

Applicants argue that the references do not disclose or suggest “separating arbitrary partial tree data in a tree structure into a plurality of partial tree data, an attribute of each separated partial tree with an attribute of a node of the partial tree data in accordance with an attribute before separation.” See, Amendment, pages 13-14.

The Examiner disagrees.

Neither claim 13, 17, nor 19 specify the argued limitation.

The correct limitation, which is believed by the Examiner to have been intended to be quoted by the Applicants is: “when separating arbitrary partial tree data in a tree structure into a plurality of partial tree data, replacing an attribute of each separated partial tree with an attribute of a node of the partial tree data in accordance with an attribute before separation.” (Emphasis added.)

In the interest of compact prosecution, it is noted that Orr teaches the limitation. Specifically, see, Orr, figures 20, 21, 23B, 23C, 23D, and 24, teaching separating partial tree data with an attribute of a node in accordance with an attribute before separation. Specifically see, Orr, figures 19-21, specifically, figure 21, teaching the separation of the partial tree data of the text page into, i.e., text paragraphs, and then reassembling the document with the original attributes to the text within the new document, all within the “design tree 314.”

Regarding claims 20 and 23:

Applicants argue that the references do not disclose or suggest "generating, when data containing pages is obtained, a new chapter which is different from chapters currently contained in document data and which contains the obtained pages." See, Amendment, pages 14-15.

The Examiner disagrees.

See, Orr, figures 19-22, and 38, and col. 23, line 63 through col. 26, line 44, teaching the insertion of a word processing document into another document, which document may be a "chapter." It is inherent that insertion of a new word processing document into a old document results in a new combined document. Therefore, it is also inherent that if the old document is a "chapter," the new combined document would, necessarily and inherently, be a "new chapter which is different from chapters currently contained in document data."

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** for the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

Art Unit: 2176


mailed until after the end of the THREE MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael K. Botts whose telephone number is 571-272-5533. The examiner can normally be reached on Monday through Friday 8:00-4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MKB/mkb


Doug Hutton
Primary Examiner
Tech Center 2100